

REMARKS

Claims 1-16, 40-42, and 65 are pending. Claims 16, 41, 42, and 65 have been withdrawn as directed to subject matter that was not elected in response to the Restriction Requirement set forth in the Office Action mailed May 13, 2010.

Claims 1, 9, and 15, as well as withdrawn claims 16 and 42, have been amended to delete the phrase “or a corresponding solvate.”

The claim amendments add no new matter.

Rejections under 35 U.S.C. § 103

Claims 1-15 and 40 have been rejected as obvious over Stevenson *et al.* (1989). Applicants respectfully traverse.

Page 6 of the Office Action particularly refers to STN International, HCAPLUS database, disclosing a compound (RN 118010-87-0) that differs from the claimed compounds. The Office Action then cites *In re Wood*, 199 U.S.P.Q. 137 (C.C.P.A. 1978) and *In re Lohr*, 137 U.S.P.Q. 548, 549 (C.C.P.A. 1963) to support its contention that the differences between the prior art and claimed compounds do not involve “a patentable modification absent unexpected or unobvious results.”

It is respectfully submitted that the Office Action’s reliance on the cited court decisions is misplaced. The law has not been properly applied to the facts of this case. That is because both *In re Wood* and *In re Lohr* deal with the obviousness of modifying compounds with the expectation of the same activity. The holding in *In re Wood* is summarized as follows

In view of the close structural similarity between the claimed compounds and Mitsuda compound III...**and the fact that the latter is disclosed as possessing antimicrobial activity**, we believe that one skilled in the art would have been, prima facie, motivated to make the claimed compounds **in the expectation that they, too, would possess antimicrobial activity**.

In re Wood at 139 (emphasis added).

Likewise, the finding of obviousness in *In re Lohr* was based on not merely because of “close structural similarity” between the compounds but also “the similar method of making the compound, **the similar properties, [and] the same use.**” *In re Lohr* at 551 (emphasis added).

In contrast to the *In re Wood* and *In re Lohr* decisions, the prior art compound cited in the Office Action is not disclosed as having the same activity as the claimed compounds, namely the *reduction in triglyceride levels in blood plasma*. See, in particular, pages 53-55 of the Applicants’ specification, under the heading “Pharmacological Data/Testing,” in which this reduction in triglyceride levels is demonstrated experimentally. In contrast, the HCAPLUS database indicates that the cited prior art compound is effective for the “kill of Spodoptera frugiperda larvae [*i.e.*, caterpillar larvae].” Likewise, the Stevenson *et al.* patent family disclosing this prior art compound (as provided in the HCAPLUS database) is directed exclusively to *insecticidal activity that is beneficial in agriculture*. See, for example, col. 2, lines 10-16 of US 5,091,405, which is a member of this patent family.

There would have been absolutely no expectation that modifying a compound, taught in the prior art to have insecticidal activity, would result in a compound capable of reducing triglycerides in blood plasma. In fact, one would hardly have believed *any positive effect* could be obtained by administering, to a patient, a compound structurally related to those used for killing insects. The demonstrated benefit of triglyceride reduction therefore clearly provides the “unexpected or unobvious results” that establish the patentability of the claimed compounds over the prior art.

Please withdraw the rejection under 35 U.S.C. § 103.

Objection to the Term “Solvate”

To advance prosecution of this application, and not as an admission that this objection is proper, the term “solvate” has been deleted from claims 1, 9, and 15. The objection is therefore now moot. This term has also been deleted from withdrawn claims 16 and 42, thereby maintaining these claims commensurate in scope with the subject matter of allowable claims 1-15 and 40.

The reason given on page 7 of the Office Action for objecting to “solvate” is that “the term is undefined by Applicant’s disclosure.” However, it is respectfully noted that there is no requirement for Applicants to define terms that already have a clearly defined meaning in the art. Rather, the specification must satisfy the standard of providing only “reasonable detail...in order to enable members of the public to understand and carry out the invention.” *Genentech, Inc. v. Novo Nordisk A/S*, 108 F.3d at 1366, 42 U.S.P.Q.2d (BNA) at 1005 (Fed. Cir. 1997). Accordingly, **a patent need not teach, and preferably omits, what is well known in the art.** *In re Buchner*, 929 F.2d 660, 661, 18 USPQ2d 1331, 1332 (Fed. Cir. 1991) (emphasis added).

The term solvate has a defined meaning in the art. In particular, this term refers to a physical form of a compound (*e.g.*, arranged in a crystalline form with molecules of solvent). For example, HACKH’S CHEMICAL DICTIONARY (4th Ed. (1969) McGraw-Hill, Inc.) defines “solvate” as a complex of the compound with molecules or ions of a solvent.

In any event, because the pending claims are directed to compounds, they embrace all forms in which these compounds reside, including, for example, a solution, a dry solid, solvate, or hydrate. Therefore, while the presently pending claims no longer recite the specific physical form, solvate, nonetheless this form still falls within the scope of the pending compound claims.

Please withdraw the objection to the term “solvate.”

Further Requirement for Restriction / Objection to Non-Elected Subject Matter

Pages 4 and 5 of the Office Action attempt to set forth a further restriction requirement, in addition to the restriction requirement imposed in the Office Action mailed May 13, 2010. This further restriction requirement, and the associated objections on page 7, based on claiming non-elected subject matter, are respectfully traversed because compliance with the stated restriction requirement is impossible. In particular, page 4 of the Office Action states that the invention now “will encompass all compounds...as follows:” The Office Action then proceeds on pages 4-5 to set forth restriction groups in which “R², R³, and R⁴ are as claimed” and also in which “R³ and R⁴ are as claimed except ‘a linear or branched C₁₋₆ alkyl group, and SOR¹⁰.’”

The Office Action therefore presents two contradictory restriction groups for R³ and R⁴. According to one restriction group, R³ and R⁴ include all claimed substituents. According to a second restriction group, R³ and R⁴ include all claimed substituents except for some substituents, including SOR¹⁰. These two proposed restriction groups are contradictory, making compliance with the Office Action’s further restriction requirement impossible. Moreover, the second restriction group is also ambiguous, because the definitions of R³ and R⁴, as claimed, do not include the substituent SOR¹⁰.

In any event, it is respectfully noted that the provisions of M.P.E.P. § 803.02 require, following an election of species, full examination of Markush-type claims to the extent necessary to determine patentability. As stated,

Following election, the Markush-type claim will be examined fully with respect to the elected species and further to the extent necessary to determine patentability.

M.P.E.P. § 803.02.

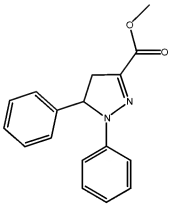
Applicants have already complied with the election of species requirement. Furthermore, no

prior art references searched to date have been found to render any claimed species unpatentable, for the reasons stated above. It is therefore respectfully requested that no further restrictions of the claimed subject matter be imposed, and that the claims be considered in their entirety.

In fact, according to M.P.E.P. § 803.02,

...it is improper for the Office to refuse to examine that which applicants regard as their invention, unless the subject matter in a claim lacks unity of invention [citations omitted]. Broadly, unity of invention exists where compounds included within a Markush group (1) share a common utility, and (2) share a substantial structural feature essential to that utility.

The presently claimed compounds clearly meet this unity of invention standard. That is, these compounds share a common utility, namely the reduction of triglycerides in blood plasma. Also, these compounds share a substantial structure feature essential to that utility, namely



with various substituents about this core structure (for example, on the phenyl rings) being possible, according to the definitions of R^1 - R^7 as defined in the claims.

Because the claims comply with the unity of invention standard based on a common utility and common structure, any further, arbitrary restriction of the claim scope to anything less than the full scope is improper, according to M.P.E.P. § 803.02. Please withdraw the further restriction requirement and the associated objection to non-elected subject matter.

Rejoinder of Claims 16, 41, 42, and 65 (M.P.E.P. § 821.04)

Applicants have elected claims directed to compounds. Non-elected claim 16 depends from claim 1 and is directed to a compound of claim 1 in combination with a second compound. Non-elected claims 41 and 42 are directed to medicaments comprising the presently claimed compounds, and non-elected claim 65 is directed to methods of using these compounds for the regulation of triglyceride levels in blood plasma.

Non-elected claims 16, 41, 42, and 65 therefore depend from the elected claims and/or have been amended in a manner commensurate with the elected claims. The non-elected claims are consequently of the same scope as the elected claims and comply with the requirements for rejoinder. Upon a finding that the elected claims are allowable, the non-elected claims must be rejoined. See M.P.E.P. § 821.04.

Applicants therefore respectfully request, upon a finding that the elected compound claims 1-15 are allowable, (1) withdrawal of requirement for restriction between Groups I, II, IV, and V, as set forth in the Office Action mailed May 13, 2010, and (2) rejoinder of withdrawn claims 16, 41, 42, and 65.

CONCLUSION

In view of the above amendments and remarks, claims 1-15, 40, and 65 are believed to be in condition for allowance. Acknowledgement of the same is respectfully requested, together with rejoinder of withdrawn claims 16, 41, 42, and 65 under M.P.E.P. § 821.04. This response is believed to address all of the substantive issues raised in the non-final office action dated August 19, 2010.

Respectfully submitted,
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